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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Shiau et al.	Confirmation No.:	9894
Serial No.:	09/830,693	Art Unit:	1631
Filed:	March 30, 1999 (§ 371 date: January 29, 2002)	Examiner:	Nashed, Nashaat T.
For:	METHODS AND COMPOUNDS FOR MODULATING NUCLEAR RECEPTOR ACTIVITY	Attorney Docket No:	61040-0013-US

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 CFR § 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Commissioner to review the requirement for restriction, mailed December 9, 2004 and made "Final" in the above-identified application.

Specifically, Applicants respectfully request:

- 1) Joinder of Groups V and VII in the instant prosecution; and
- 2) Joinder of claims 1–25, 29–35, 39, 52–133, and 140–141, from Groups I, II, III, and VIII, into a single group, at such time as any of groups I, II, III or VIII is elected for further prosecution.

Applicants assert that they have satisfied the statutory requirements for filing the instant petition because they have requested reconsideration of the restriction (see remarks filed August 19, 2004, and on even date herewith) and made an election with traverse (on August 19, 2004).

Background to Petition

The instant application is U.S. national phase application of PCT/US99/06937, for which restriction practice is governed by the "unity of invention" standard applicable under PCT Rules 13.1 and 13.2. See *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590; see also Examiner's comments, Office Action mailed

December 9, 2004, at page 2. Under such a standard, unity of invention exists for claims that possess one or more “special technical features” in common.

A restriction into ten (10) groups of claims was mailed June 25, 2004. Applicants timely responded, August 19, 2004, with a request for reconsideration, and a provisional election with traverse.

A subsequent restriction into eight (8) groups of claims was mailed December 9, 2004, and made final. Applicants timely respond, on even date herewith, with a further request for reconsideration, in connection with a response under 37 C.F.R. § 1.111.

The essence of Applicants’ request for reconsideration is as follows:

1) with respect to Groups V and VII, Applicants respectfully submit that the special technical features common to all of the claims in Groups V and VII are: the estrogen receptor ligand binding domain; an agonist bound to the ligand binding domain; and a molecule bound to the coactivator binding site. Accordingly, Applicants respectfully submit that the claims of groups V and VII satisfy the unity of invention standard and request joinder thereof for the instant prosecution.

2) with respect to certain claims in Groups I, II, III, and VIII, Applicants respectfully submit that, according to the Examiner’s own identification of a “special technical feature” in the claims of Groups I, III and VIII, at least claims 29–33 and 67–71 of Group II should properly be examined with one of groups I, III, or VIII. Additionally, Applicants believe that the Examiner’s grounds for separating the claims of Groups I, II, III, and VIII are improper, according to practice under PCT Rules 13.1 and 13.2, and hereby request joinder of all claims presently classified in Groups I, III, and VIII, as well as at least claims 29–33, and 67–71 in Group II, into a single group at such time as any such claims are elected for further prosecution.

In the alternative, Applicants respectfully submit that all claims in Groups I, II, III and VIII, except for claims 134 and 135, possess the following special technical features and, accordingly, should be joined into a single group at such time as any such claims are elected for further prosecution:

an atomic structural model of the estrogen receptor ligand binding domain, comprising atomic coordinates of:
helix 12 of the ligand binding domain;
a coactivator binding site, and
a coactivator bound to the coactivator binding site.

Applicant respectfully refers the Commissioner to remarks presented in connection with a response under 37 C.F.R. § 1.111, mailed on even date herewith, for further discussion of Applicants’ request for reconsideration of the restriction.


Conclusion

Applicants state that the arguments presented herein are not be construed as an admission that any of the claims of any of groups I, II, III, and VIII are obvious over, or are not patentably distinct from, the claims of any other of such groups, or that the claims of Group V are obvious over, or are not patentably distinct from, the claims of Group VII.

No fee is believed owing with this petition. However, should the Commissioner determine otherwise, he is authorized to charge any required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 61040-0013). A copy of this sheet is enclosed.

Date: March 9, 2005

Respectfully submitted,



Richard G. A. Bone
Limited Recognition Under 37 C.F.R. § 11.9(b)
(Copy of Certificate attached hereto)

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